IN THE HIGH COURT OF JUDICATURE AT BOMBAY
O. O. C. J.

WRIT PETITION NO.2133 OF 1992

Velcro Industries B.V. ...Petitioners.
Vs.
The Registrar of Trade Marks & Ors. ...Respondents.
....
Mr. Ravi Kadam with Mr. Ramesh Gajria i/b. Gajria & Co. for the Petitioners.
Mr. D.A. Dubey for Respondnet Nos.1, 2 and 4.
.....

CORAM : S.RADHAKRISHNAN &
DR.D.Y.CHANDRACHUD, JJ.

November 25, 2004.

P.C.:

We have heard learned Counsel for the Petitioners and learned Counsel for Respondent Nos.1, 2 and 4. None appears for Respondent No.3.

2. In the above petition a very short issue is raised. The Petitioners herein, had filed a suit in the year 1989 in this Court being Suit No.1297 of 1989 against Respondent No.3 for infringement and passing off of the Trade Mark. On 27th April 1989, the Petitioners were granted ad-interim relief. Subsequently, Respondent No.3 had filed an affidavit in reply on 27th April 1989. Thereafter, on 14th November 1991, Respondent

No.3 filed further affidavit inter alia contending that the Petitioners have lost their rights in the mark and that registration was deceptive and the mark had become generic. Respondent No.3 filed further affidavit on 27th January 1992 contending that the Petitioners herein, had lost its distinctiveness and the mark has become publici juris.

3. On 26th June 1992, the Deputy Registrar of Trade Mark had issued a notice under Section 56(4) of the Trade and Merchandise Marks Act, 1958, (hereafter referred as "the said Act") which reads as under:

> "56(4) The Tribunal, of its own motion, may, after giving notice in the prescribed manner to parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2)."

4. The learned counsel for the Petitioners Shri Kadam has drawn out attention to the definition of "Tribunal" as per Section 2 of the said Act and pointed out that "Tribunal" means the Registrar or, as the case may be, the High Court before which the

proceeding concerned is pending. Shri Kadam, learned Counsel, contended that in view of Section 107 of the said Act, the Deputy Registrar of Trade Mark could not have issued notice under Section 56(4) for rectification since Section 107 of the Act, makes it abundantly clear that even if an application is made for rectification of the register, the same has to be made to the High Court and not to the Registrar, as the above suit No.1297 of 1989 was pending with High Court at the time of issuance of the above notice under Section 56(4) of the said Act.

5. Shri Kadam brought to our notice that this issue was squarely considered and determined by the Supreme Court in the case of **Whirlpool Corporation vs. Registrar of Trade Marks,** (1998) 8 SCC 1 wherein it was clearly held that during the pendency of the proceedings before High Court, Registrar of Trade Marks cannot issue any notice under Section 56(4) to show cause.

6. In view of the said judgment of the Supreme Court, the issue involved in the present petition is squarely covered. Under the aforesaid facts and circumstances, Rule is made absolute in terms of prayer clause (a). However, with no order as to costs.

7. The learned Counsel for the Petitioners brought to our notice that during the pendency of the above Petition, the dispute between the petitioners and the Respondent in the above suit, has been amicably settled and Consent Terms have already been filed and the suit has been accordingly disposed of.

(S.RADHAKRISHNAN, J.)

(DR.D.Y.CHANDRACHUD, J.)